

REMARKS

Claims 1-20 were pending in this application.

Claims 1-20 have been rejected.

Claims 21-26 have been added.

Claims 1-26 are now pending in this application.

Reconsideration and full allowance of Claims 1-26 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-5, 7-9, and 11-17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,324,387 to Kamgar et al. (“*Kamgar*”) in view of U.S. Patent No. 6,822,696 to Talmola et al. (“*Talmola*”). The Office Action rejects Claims 6, 10, and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over *Kamgar* and *Talmola* in view of U.S. Patent No. 5,734,974 to Callaway, Jr. et al. (“*Callaway*”). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d

1443, 1444 (*Fed. Cir. 1992*); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (*Fed. Cir. 1993*)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (*Fed. Cir. 1992*); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (*Fed. Cir. 1985*)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (*Fed. Cir. 1993*)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. (*MPEP* § 2142).

Kamgar recites a receiver having an amplifier 105 and a controller 110 that adjusts the gain of the amplifier 105. (*Abstract; Figure 1*). A comparator 150 compares an "RSSI" signal to a voltage reference " T_r " and outputs a signal 160, and a comparator 155 compares a "Pilot Power" signal to a voltage reference " T_p " and outputs a signal 165. (*Col. 4, Lines 44-53*). The signals 160 and 165 are used by the controller 110 to determine how the gain of the amplifier 105 is adjusted. (*Col. 5, Lines 6-56*). As shown in Table 1 of *Kamgar*, "Condition 2" involves

decreasing the gain of the amplifier 105 when the RSSI signal exceeds the voltage reference T_r and the Pilot Power signal does not exceed the voltage reference T_p . (*Col. 5, Line 26*).

Talmola recites a television receiver capable of receiving both analog and digital signals. (*Abstract*). The receiver includes an RF amplifier 304 and a controller 318. (*Figure 1*). The controller 318 adjusts a bias current provided to the RF amplifier 304 based on the bit error rate (BER) of the received digital signals. (*Col. 3, Lines 4-7*). For example, the controller 318 may decrease the bias current when the BER is better than an acceptable level and increase the bias current when the BER is worse than an acceptable level. (*Col. 3, Lines 8-33*).

The Office Action states that *Kamgar* does not disclose increasing “a current supplied to the one or more first amplifiers” in response to “the amplified incoming signal exceeding a first threshold and the desired signal not exceeding a second threshold” as recited in Claims 1, 7, and 15. (*Office Action, Page 2, Last paragraph*). The Office Action then asserts that *Talmola* discloses these elements of Claims 1, 7, and 15 and that it would be obvious to modify *Kamgar* with *Talmola*. (*Office Action, Page 2, Last paragraph – Page 3, First paragraph*).

Modifying *Kamgar* with the circuit of *Talmola* would fail to disclose, teach, or suggest the Applicant’s claimed invention as recited in Claims 1, 7, and 15. *Kamgar* recites adjusting the gain of an amplifier based on comparing two signals to two voltage references. *Talmola* recites adjusting a bias current supplied to an amplifier based on an error rate of a received signal. At most, this might suggest that *Kamgar* could be modified to both:

- (i) adjust the gain of the amplifier 105 based on comparing two signals to two voltage references; and

(ii) adjust the bias current of the amplifier 105 based on an error rate of a received signal.

However, nothing in *Talmola* suggests that the bias current of an amplifier should be increased based on comparing two signals to two voltage references. For example, nothing in *Talmola* suggests that adjusting the bias current supplied to the amplifier 105 of *Kamgar* could help the Pilot Power signal of *Kamgar* to exceed the T_p voltage reference.

Basically, the Office Action identifies two different functions from two different cited references, but the different functions are performed based on completely different criteria. Adjusting the gain of an amplifier is based on comparing two signals to two voltage references in *Kamgar*, and adjusting the bias current of an amplifier is based on an error rate in *Talmola*. The Office Action fails to establish that the function of *Talmola* (adjusting the bias current of an amplifier) could be based on the criteria of *Kamgar* (comparisons of two signals to two voltage references). The Office Action fails to identify any portion of any reference disclosing, teaching, or suggesting that adjusting the bias current of an amplifier as performed in *Talmola* can be based on comparing two signals to two voltage references as performed in *Kamgar*.

For these reasons, the Patent Office cannot show that the proposed *Kamgar-Talmola* combination discloses, teaches, or suggests increasing “a current supplied to the one or more first amplifiers” in response to “the amplified incoming signal exceeding a first threshold and the desired signal not exceeding a second threshold” as recited in Claims 1, 7, and 15. The Patent Office therefore has not established a *prima facie* case of obviousness against Claims 1, 7, and 15 (and their dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 1-20.

II. NEW CLAIMS

The Applicant has added new Claims 21-26. The Applicant respectfully submits that no new matter has been added. At a minimum, the Applicant respectfully submits that Claims 21-26 are patentable for the reasons discussed above. The Applicant respectfully requests entry and full allowance of Claims 21-26.

III. CONCLUSION

The Applicant respectfully asserts that all pending claims in this application are in condition for allowance and respectfully requests full allowance of the claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Applicant has included the appropriate fee to cover the cost of this AMENDMENT AND RESPONSE. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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